

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** SHIGEKAZU WAKATA and EIJI SAIJO

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Appeal No. 98-1253  
Application No. 08/249,931<sup>1</sup>

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ON BRIEF

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Before CALVERT, MEISTER, and STAAB, ***Administrative Patent Judges.*** MEISTER, ***Administrative Patent Judge.***

***DECISION ON APPEAL***

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<sup>1</sup> Application for patent filed May 26, 1994.

Shigekazu Wakata and Eiji Saijo (the appellants) appeal from the final rejection of claims 1 and 7-17, the only claims remaining in the application.<sup>2</sup>

We AFFIRM-IN-PART and, pursuant to authority under the provisions of 37 C.F.R. § 1.196(b), we will enter new rejections of claims 7-16 under 35 U.S.C. § 112, second paragraph.

The appellants' invention pertains to (1) a rubber plug for a waterproof connector, (2) a waterproof seal for use in a connector and (3) a waterproof connector utilizing such a plug and seal. Independent claims 1, 7 and 11 are further illustrative of the appealed subject matter and copies thereof may be found in the appendix to the brief.

The references relied on by the examiner are:

|                              |           |          |
|------------------------------|-----------|----------|
| Otani et al. (Otani)<br>1980 | 4,214,802 | Jul. 29, |
| Vogel<br>1989                | 4,828,509 | May 9,   |
| Scowen<br>1992               | 5,098,315 | Mar. 24, |

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<sup>2</sup> Claims 7 and 9 have been amended subsequent to final rejection.

Appeal No. 98-1253  
Application No. 08/249,931

Claims 1 and 7-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Otani.<sup>3</sup>  
Claims 1 and 7-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Scowen in view of Vogel.

The rejections are explained on page 3 of the answer. The arguments of the appellants and examiner in support of their respective positions may be found on pages 4-18 of the brief, pages 3-15 of the reply brief, pages 4 and 5 of the answer and page 5 of the "supplemental answer."<sup>4</sup>

#### **OPINION**

Considering first the rejection of claims 1, 7-9, 11-15 and 17 under 35 U.S.C. § 102(b) as being anticipated by

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<sup>3</sup> This rejection was set forth as a new ground of rejection on page 3 of the answer (Paper No. 18).

<sup>4</sup> Although the action mailed November 6, 1997 (Paper No. 21) was styled a "SUPPLEMENTAL EXAMINER'S ANSWER," this action inexplicably repeated the answer (Paper No. 18) in its entirety (including the previously set forth new ground of rejection just as if it was now being set forth for the first time), except that (1) the last line of page 3 of the answer was apparently inadvertently omitted and (2) the following sentence was added on page 5: "The examiner has carefully reviewed the reply brief filed July 28, 1997 and has concluded that his position is clear and complete."

Appeal No. 98-1253  
Application No. 08/249,931

Otani, we initially note that the terminology in a pending application's claims is to be given its broadest reasonable interpretation (*In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)), and limitations from a pending application's specification will not be read into the claims (*Sjolund v. Musland* 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1989)). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be

possessed by the prior art reference. *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently (*In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997));

however, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (*Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983)).

On pages 4-6 of the reply brief the appellants concede that Otani teaches a "rubber" plug 52, coaxial annular ribs or collars

56 and an end plug portion which has an "umbrella-like effect" but, nevertheless, contend that the entire end plug portion cannot be considered to be "umbrella-shaped" since there is a flat portion thereon. We must point out, however, that the specification provides no particular definition of "umbrella shape," and umbrellas are made in many different shapes.

Accordingly, giving this terminology its broadest reasonable interpretation, we are of the opinion that the end plug portion

52' of Otani can be considered to be of "an umbrella shape" as broadly claimed (see, e.g., Fig. 4).

It is also the appellants' contention that since the end plug portion 52' of Otani has a flat portion thereon, it does not direct fluid "away from the wire" that is inserted therethrough. This argument is relevant, at the most, to claims 11-15 and 17 since these are the only claims under consideration which require a surface for directing fluid away from the wire. Even with respect to these claims, however, Otani's end plug portion 52, as depicted in Fig. 4 has a beveled or inclined portion extending around the outer periphery which forms "a surface" that would direct fluid in a direction away from the wires 76'. Thus, although the appellants are correct in noting that Otani end plug portion also includes a flat portion, there is simply no claim limitation which would preclude the arrangement of Otani.<sup>5</sup>

With respect to claims 9 and 15 the appellants argue that Otani does not teach a lip portion that "is tapered such that its diameter progressively increases" in a direction away from the flange-like collars. We are at a loss to understand such a

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<sup>5</sup> It is well settled that features not claimed may not be relied upon in support of patentability. *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

contention since the above-noted beveled or inclined portion can

be broadly considered to be on the lip, and does indeed have a diameter which "progressively increases" and extends away from the ribs or collars 56.

In view of the foregoing, we will sustain the rejection of claims 1, 7-9, 11-15 and 17 under 35 U.S.C. § 102(b) as being anticipated by Otani.

Turning to the rejection of claims 1, 7-9, 11-15 and 17 under 35 U.S.C. § 103 as being unpatentable over Scowen in view of Vogel, the examiner is of the opinion that it would have been obvious to make the end plug portions of the plugs 42 of Scowen of an "umbrella shape" in view of the teachings of Vogel.<sup>6</sup> We do not agree. The examiner has correctly noted that (1) Scowen discloses elastomeric plugs 40 for sealing passages 34 in a connector 14 and (2) Vogel teaches a plug 22

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<sup>6</sup> We are at a complete loss to understand why the examiner did not utilize the "known" (specification, page 1, line 7) or "conventional" (specification, page 4, lines 3 and 6) rubber plug/connector depicted by the appellants in Figs. 5 and 6 of the drawings, and modify this "known" or "conventional" plug/connector by providing an end plug portion of umbrella shape in view of the teachings of Vogel.

Appeal No. 98-1253  
Application No. 08/249,931

for sealing a "tubular" passage in a connector 24 that is of umbrella shape for the purpose of deflecting liquids away from the passage (see, e.g., column lines 10-12). We observe, however, that the "tubular" passage in Vogel is formed or defined by a generally cylindrically-shaped wall and a necessary part of Vogel's sealing arrangement is an "umbrella-like" cover 56 that has a non orthogonal recess for the purpose of cooperating with a bevel like lip 58 formed on the outer end of the generally cylindrically-shaped wall which defines the passage. In Scowen the passages are not formed or defined by a generally cylindrically-shaped wall having a lip portion. Instead, Scowen's connector 14 has three adjacent passages or cavities 34 formed in the connector body, which body terminates in a generally flat end structure having a top and bottom that are parallel to one another and sides that are rounded. Since Scowen's passages are not defined by a cylindrical wall having a lip portion and Vogel teaches that it is essential that the plug portion having an "umbrella shape" cooperate with such a cylindrical wall and lip, we do not believe that there is anything in the combined teachings of Scowen and



Appeal No. 98-1253  
Application No. 08/249,931

Vogel which would fairly suggest combining their teachings in such a manner so as to arrive at the claimed invention as the examiner has proposed. Accordingly, we will not sustain the rejection of claims 1, 7-9, 11-15 and 17 under 35 U.S.C. § 103 based on the combined teachings of Scowen and Vogel.

Turning to the rejections of claims 10 and 16 under 35 U.S.C. § 102(b) as being anticipated by Otani and under 35 U.S.C. § 103 as being unpatentable over Scowen in view of Vogel, we have carefully considered the subject matter defined by these claims. However, for reasons stated *infra* in our new rejection of claims 10 and 16 under 35 U.S.C. § 112, second paragraph, as being indefinite, no reasonably definite meaning can be ascribed to certain language appearing in these claims. In comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection on prior art cannot be based on speculations and assumptions (see *In re Steele*, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96

Appeal No. 98-1253  
Application No. 08/249,931

(CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)), we are constrained to reverse the examiner's rejections of claims 10 and 16 under 35 U.S.C. 102(b) and 35 U.S.C. § 103. We hasten to add that this is a procedural reversal rather than one based upon the merits of the §§ 102(b) and 103 rejections.

Under the provisions of 37 C.F.R. 1.196(b) we make the following new rejections:

Claims 7-16 are rejected under 35 U.S.C. § 112, second paragraph. In order to satisfy the requirements of the second paragraph of § 112, a claim must accurately define the invention in the technical sense. *See In re Knowlton*, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973). Here, each of the claims under consideration require that the plug form a seal between the **terminal** and the passage. According to the specification, however, the element 30 is the "terminal" (see, e.g., page 4, line 26). Clearly there is no seal formed between this element and the passage. That is,

while the plug may be considered to form a seal between the wire 20 and the wall of the passage (see claims 1 and 17), there is clearly no seal between the **terminal 30** and the wall of the passage (note, e.g., Fig. 2 clearly shows a significant space between the insulation barrel 31 of the terminal 30 and the wall of the passage). Claims 15 and 16 (which are directed to the embodiment of Fig. 3) are further inaccurate since they depend indirectly from claim 11 which sets forth that the surface directs fluid "away from the wire." In the embodiment of Fig. 3, however, the end plug "surface" directs fluid **toward** the wire.

Claims 10 and 16 are further rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention. Both of these claims set forth "said tapered end plug," however, there is no antecedent basis for such a recitation. In apparent contradiction to the end plug being tapered as recited, the claims from which claims 10 and 16 depend only refer to the lip portion as being

Appeal No. 98-1253  
Application No. 08/249,931

"tapered." Accordingly, one of ordinary skill in this art is left to speculate as to what is to be considered "tapered."

In summary:

The rejection of claims 1, 7-9, 11-15 and 17 under 35 U.S.C. § 102(b) is affirmed.

The rejection of claims 1, 7-9, 11-15 and 17 under 35 U.S.C. § 103 is reversed.

The rejections of claims 10 and 16 under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 are reversed.

New rejections of claims 7-16 under 35 U.S.C. § 112, second paragraph, have been made.

In addition to affirming the examiner's rejection of one or more claims, this decision contains new grounds of rejection pursuant to 37 C.F.R. § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 C.F.R. § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 C.F.R. § 1.197(b) provides:

Appeal No. 98-1253  
Application No. 08/249,931

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 C.F.R. § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 C.F.R. § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before

Appeal No. 98-1253  
Application No. 08/249,931

the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

***AFFIRMED-IN-PART***  
***37 C.F.R. § 1.196(b)***

|                             |   |                 |
|-----------------------------|---|-----------------|
| IAN A. CALVERT              | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) | BOARD OF PATENT |
| JAMES M. MEISTER            | ) | APPEALS         |
| Administrative Patent Judge | ) | AND             |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
|                             | ) |                 |
| LAWRENCE J. STAAB           | ) |                 |
| Administrative Patent Judge | ) |                 |

Appeal No. 98-1253  
Application No. 08/249,931

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Appeal No. 98-1253  
Application No. 08/249,931

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